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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,911	03/13/2002	Florence L'Alloret	220758USOPCT	2979

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
FUBARA, BLESSING M	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/070,911	L'ALLORET ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *05/22/02 &09/02/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of response to election requirement and remarks filed 05/05/04. Claims 1-33 are pending.

Election/Restrictions

Applicants elected methacrylic acid monomeric units, polyurethane as the water-soluble units and polyethers; applicants further indicated that claims 1-8 and 16-33 read on the elected species. Applicants vigorously traverse the election on the grounds that there was no lack of unity of invention in the PCT. It is noted that applicants do not make any statement regarding the species as patentably distinct but applicants rather maintain that the restriction is improper because the Office provided no reasons or examples to support the conclusion that the species are patentably distinct. The Office action of 04/06/2004 is not a restriction but an election requirement for the applicants to narrow the species for examination purposes. For example, claims 5 and 6 lists a number of monomeric units that may be present in the polymer of the cosmetic. The number of the monomeric units would present burden on the Examiner if the Examiner were to search each monomer. Similarly, claim 12 and 14 presents list for the LCST polymer. Furthermore, applicants in the response failed to indicate that those species are equivalent but rather state that statement of the distinctness of the species will not be made. However, the election requirement is withdrawn and the pending claims are considered.

Priority

Applicants' claim for foreign priority based on an application filed in France on 01/15/01 is acknowledged. It is noted , however, that applicants have not filed a certified copy of the French application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

The citation of pending applications is received and recorded with the application, however, pending applications are not prior art and have not been considered as such.

Specification

The abstract of the disclosure is objected to because the abstract of the disclosure is written in three paragraphs. And MPEP § 608.01(f) requires that the abstract be a brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. Correction is respectfully requested.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 5, 8, 10, 12 and 15-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites "especially" in line 3 and this creates a related process within the generic polymerization process.

Claims 10, 12 and 15-17 recite "preferably" creating a range within a range situation.

3. Regarding claim 8, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Claims 26-32 provide for the use of polymer composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 26-32 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Objections

5. Claims 7-9, 12, 13, 16-20, 22-25 and 33 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternatively only and cannot depend from any other multiple dependent claims. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8, 12-25 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Torgerson et al. (US 5,730,966).

Torgerson discloses a polymer that comprises a water or alcohol soluble thermoplastic elastomeric copolymer (abstract). The polymer comprises repeating units of A and B polymerizable monomers (column 2, lines 61-65), monomer A is as described in column 3, lines 1-16) and monomer B is as described in column 3, lines 17-64). The A and B monomers are related as copolymers in the polymeric composition of Torgersen and the molecular weight of the copolymer is in the range of 10,00 to 5,000,000 (column 6, lines 5-17). A monomers are the acrylates (column 8, lines 16-67); B monomers are the N-vinylpyrrolidones, N-vinylcaprolactams (column 10, lines 13-46). Propylene glycol, ethylene glycol, acrylates, caprolactones and imidazoles are disclosed as momomers (columns 3-11). The Tg of the side chains is greater than 25 °C (column 2, line 56) and 40 °C is greater than 25 °C. The polymers and monomers disclosed by the prior art meet the limitations of the monomers and polymers of the instant claims. The teaching of Torgerson meets the limitations of the claims.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yeo (US 5,509,913) discloses polymers that read on the claimed polymers that have the same lower critical solution temperature or LCST (column 5, line 48; column 9 line 25 to column 10; column 11, line 59 to column 12 line 7).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-17, 22-25 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-15, 20, 16, 17, 31-35, 38 an 39; 26-48; and 53-60, 62-65 and 68 of copending Application Nos. 10/070,922; 10/070,910 and 10/197,560 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are overlapping and intended use is not critical in composition claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-17 and 22-25 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,689,956. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap and future intended use is not critical in composition claim.

12. Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-55, 57-69; 53, 55-57, 62-68 and 75-84; and 1-17 of copending Application Nos. 10/069,981; 10/197,555 and

10/197,560. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification and in the claims..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600